REMARKS/ARGUMENTS

The rejections presented in the Office Action dated April 20, 2005 (hereinafter Office Action) have been considered. Claims 1-19 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present amendments and response is respectfully requested.

Claim 18 stands rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicant traverses the rejection. Applicant respectfully disagrees with the Office Action's characterization of a "proxy" as a computer data structure or a program listing. The common usage of the term "proxy" in the relevant art, along with the limitations included in the claim, clearly support the assertion that the "proxy" of Claim 18 is not a disembodied computer program or data structure. For example, a disembodied computer program would be incapable of "transmitting the modified content requests to the mobile server." The Office Action quotes MPEP § 2106.IV.B.1.a in support of this rejection, but this same section of the MPEP also states "[o]ffice personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim."

Applicant asserts that Claim 18 as originally filed is drawn to a statutory manufacture or machine. However, in order to facilitate prosecution of the Application Claim 18 has been amended to use the term "proxy server." Therefore, Applicant respectfully requests withdrawal of the rejection of Claim 18.

Claims 1, 4-5, 9-13, and 16-19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0028612 to Lin et al. (hereinafter *Lin*). Applicants respectfully traverse the rejection. To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Lin* does not meet this standard.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §

2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the patent claim; i.e. every element of the claimed invention must be literally present, arranged as in the claim." MPEP § 2131, quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). With respect to independent Claims 1, 9, and 16-19, the Applicant submits that *Lin* does not teach every element of these claims, as originally filed and particularly as amended, and therefore fails to anticipate these claims.

Independent Claims 1, 9, and 16-19 are directed to a mobile terminal that operates as a network server. Content requests originating from a first network are targeted for the mobile terminal is operable on a second network. Elements operable on the second network are not addressable via the first network. The requests include a destination path having an identifier that is addressable on the first network and a mobile terminal identifier of the mobile terminal. The destination paths in the requests are modified to indicate that a network path corresponding to the mobile terminal is the source of the content. *Lin* at least fails to describe or otherwise suggest sending content requests that include a destination path having an identifier that is addressable on the first network and a mobile terminal identifier of a mobile terminal operable on a second network, wherein elements operable on the second network are not addressable via the first network. *Lin* also fails to describe modifying destination paths in content requests received via the first network to indicate that the path of mobile terminal on the second network is the source of the content.

Lin is generally directed to a system for caching mobile device data at a proxy server. In *Lin*, a support node 210 allows a mobile terminal 204 to utilize caching of terminal server data on a virtual server portion 102 that resides on a proxy server 214 (see FIG. 2, and [0018]). *Lin* fails to describe destination paths that contain an identifier that is addressable on the first network and a mobile terminal identifier of the mobile terminal. *Lin* is silent as to composition of the network requests, merely stating that "user equipment 204 may be assigned its public network address if it does not already have one" and that the "support node 210 sets up a process that maps the public network address of user equipment 204 to an address of a virtual server" ([0032]). In contrast, Claims 1, 9, and 6-19 are

directed to a destination path having a mobile terminal identifier and an identifier that is addressable on the first network (*see, e.g.,* p. 14, lines 7-12 of the instant Specification, where an example URI pathname includes an Internet-addressable "domain-name" identifier and an MSISDN identifier of a mobile terminal). Therefore, *Lin* fails to describe the composition of destination paths as required by Claims 1, 9, and 6-10.

Lin also fails to describe the terminals as not being addressable on the network from which the requests originated. On the contrary, Lin describes the terminals as being addressable on the public networks - "[t]he request preferably includes a public network address, such as the IP address or domain name for the user equipment or the user's server service" ([0031)]. Similarly, *Lin* describes the terminals and requesting clients as operating on the same network - "[n]etwork 212 provides for data communications among client devices 216, ... and user equipment 204" ([0027]). In contrast, Claims 1, 9, and 6-19 are directed to network elements operable on a second network that are not addressable from a first network, the first network being the network from where the content requests originate *(see, e.g.*, p. 2, lines 24-29 of the instant Specification, pertaining to mobile terminals that are not accessible via IP networks, thus unable to service requests originating from Internet users).

Also, *Lin* does not describe modifying destination paths of the request to indicate that the mobile terminal is the source of the content, as recited in Claims 1, 9, and 6-19. In paragraphs [0036]-[0037] relied on in the Office Action, *Lin* merely describes routing the request to the support node 210, which then routes requests to the virtual server portion 102. *Lin* is silent on the mechanisms used to accomplish this routing. In particular, *Lin* does not describe modifying destination paths of the request in order to accomplish this routing.

Therefore, *Lin* fails to each and every limitation of independent Claims 1, 9, and 6-10, and Applicant respectfully submits these claims are in condition for allowance. Dependent Claims 4-5 and 10-13 depend respectively from independent Claims 1 and 9. These dependent claims also stand rejected under 35 U.S.C. §102(e) as being anticipated by *Lin.* While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with

independent Claims 1 and 9. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Lin*. Therefore, dependent Claims 4-5 and 10-13 are also in condition for allowance.

Claims 6-7, and 14-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Lin* in view of U.S. Publication No. 2002/0123335 to Luna et al. (hereinafter *Luna*). Applicants respectfully traverse the rejection. According to MPEP §2142, to establish a prima facie case of obviousness under 35 U.S.C. §103:

> 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
>
> 2) there must be a reasonable expectation of success; and
>
> 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant respectfully submits that the combination of *Lin* in view of *Luna* does not teach or suggest all of the limitations of Claims 6-7, and 14-15. As described above in relation to Claims 1 and 9 (from which Claims 6-7 and 14-15 respectively depend) *Lin* at least fails to teach or otherwise suggest sending content requests with a destination path having an identifier that is addressable on the first network and a mobile terminal identifier of the mobile terminal. *Luna* also fails to teach or suggest these limitations. *Luna* is directed to provisioning a wireless mobile device via a network. *Luna* is not directed to providing network services from the terminal. As such, *Luna* is silent on receiving service requests directed to a mobile terminal acting as a network server, because the terminals in *Luna* do not act as servers. Thus the combination of *Lin* and *Luna* fails to teach or suggest sending content requests with a destination path having an identifier that is addressable on a first network and a mobile terminal identifier of the mobile terminal

Further, Applicant submits that there is no motivation to combine *Lin* with *Luna* as suggested in the Office Action. Neither *Lin* nor *Luna* are directed to providing network

services from a mobile device that is not addressable on networks from which requests originate. *Lin* is directed to proxy services for mobile terminals that are already described as being accessible by elements operating on the networks where requests originate. *Luna* merely describes providing provisioning data to a mobile terminal. Neither the references themselves or knowledge available to one skilled in the art would motivate combining *Lin* with *Luna* because neither reference recognizes the problem associated with a mobile server that is not addressable from another network from where content requests may originate. Therefore, Applicant respectfully submits that a *prima facie* case of obviousness with respect to *Lin* and *Luna* has not been established, and Claims 6-7, and 14-15 are in condition for allowance.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Lin* in view of *Luna* and in further view of U.S. Publication No. 2003/0035409 to Wang et al. (hereinafter *Wang*). Applicants respectfully traverse the rejection. The Applicant respectfully submits that the combination of *Lin* and *Luna* in view of *Wang* does not teach or suggest all of the limitations of Claim 8. As described above in relation to Claim 1 (from which Claim 8 depends) the combination of *Lin* and *Luna* at least fails to teach or otherwise suggest sending content requests to a mobile terminal operating on a second network, where the request includes a destination path having an identifier that is addressable on the first network and a mobile terminal identifier of the mobile terminal. *Wang* also fails to disclose this feature of Claims 8.

Wang is generally directed to providing control and policy enforcement of WAP services. In paragraph [0023] of *Wang* relied upon in the Office Action, Wang describes the use of an MSISDN in requests that originate from the mobile terminal that are sent to an external server (*e.g.*, in [0022] *Wang* states "the WAP standard does not allow the [mobile] device to send in a unique identifier in its requests, where one such identifier may be ... the MSISDN"). *Wang* does not at least describe the modification of a destination path for a request directed to a mobile terminal that is acting as a server, because *Wang* does not describe a mobile terminal acting as a server. Therefore, the combination of *Lin*, *Luna,* and

Wang fail to teach or suggest at least this limitation of Claim 8, and Claim 8 is also in condition for allowance.

Claims 2-3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Lin* in view of U.S. Publication No. 2003/0105864 to Mulligan et al. (hereinafter *Mulligan*). Applicant respectfully traverses the rejection. While Applicant does not acquiesce to the particular rejections to these claims, it is believed that these rejections are moot because *Mulligan* is not a proper reference under 35 U.S.C §103(c). Section 103(c) states in relevant part:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants first note that both the instant application and *Mulligan* are assigned to a common assignee, Nokia Corporation. Applicant makes reference to the assignee of record for *Mulligan* (recorded at reel 012975, frame 0938) and the assignee of record information for the instant Application (recorded at reel 014555, frame 0526) to evidence common ownership by Nokia Corporation. Secondly, Applicant has verified that the inventors of *Mulligan* and the inventor of the instant Application were under a common duty of assignment to Nokia Corporation at the time of their respective inventions. Therefore, Applicants respectfully request withdrawal of the rejection because, *Mulligan* is not a proper reference, and, as stated in the Office Action, *Lin* does not teach or suggest each and every limitation of Claims 2-3.

If the Examiner believes it helpful or necessary, the undersigned agent of record invites the Examiner to contact him at 952-854-2700 to discuss any issues related to this case.

Respectfully submitted,

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By: _____

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